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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/663,979	09/17/2003	Daniel M. Marks	110293.133US1	1953
61302 7590 10/11/2007 PTT LLC (D/B/A HIGH 5 GAMES) 1200 MACARTHUR BLVD MAHWAH, NJ 07430			EXAMINER THOMASSON, MEAGAN J	
			ART UNIT 3714	PAPER NUMBER
			MAIL DATE 10/11/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/663,979

Applicant(s)

MARKS ET AL.

Examiner

Meagan Thomasson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 29-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 May 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

The examiner acknowledges the amendments made to claims 29,30 and 31.
Claims 32 and 33 have been added, claims 1-28 are canceled.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 31 and 33 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claim 31, the limitation that "a wildcard symbol expands N symbol positions ... **with N indicated on the wildcard symbol**" is not supported by applicant's specification nor by applicant's drawings. The Any Number of Wild Symbols paragraph on P. 12 of applicant's specification does states that "The present invention allows for any number of wild symbols to appear on the slot reels and expand into any number of other symbol positions. For example, wild symbols may appear at symbol positions ½, 3/1 and 4/3 and expand to cover all positions in the symbol matrix", which substantially

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supports the limitation that "a wildcard symbol expands in N symbol positions".

However, the limitation that N is indicated on the wildcard symbol constitutes new matter. For purposes of examination, the claim will be examined as:

... a wildcard symbol expands N symbol positions, from the symbol position in which the wildcard symbol appears towards the predetermined direction(s) assigned by the directional indicia displayed on the wildcard symbol, with N calculated in one of the following manners...

Regarding claim 33, neither applicant's specification nor applicant's drawings provide support for the limitation that "arrows are used as directional indicia displayed on the wildcard symbols". The limitation of arrows used as directional indicia thus constitutes new matter.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 29-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Benett (US 6,585,264 B2) in view of Locke (US 2003/0022712).

Benett discloses an electronic gaming device and method wherein a player places a wager, a plurality of symbols are arranged and displayed, including wildcard symbols, wherein said wildcard symbols are expandable in a plurality of directions. The player is then awarded based on various symbol combinations. The direction of the wildcard symbol expansion may be upwards, downwards, leftwards, rightwards or diagonally from the symbol position in which the wildcard symbol appears (see Figs. 3-8). Each of the symbols has a predetermined movement pattern that is determined, i.e. assigned by, the indicia displayed on the wildcard symbol (col. 1, lines 62-65). For example, a "Bishop" piece may only move in a diagonal direction, as governed by the fact that it is a "Bishop". Upon completion of the symbol expansion process, a player may then be awarded a prize for obtaining a winning symbol combination (col. 2, lines 30-32).

Column 3, lines 43-51, describe the gaming method as upon the occurrence of a wildcard symbol, referred to by Benett as a chess symbol, the wildcard symbol will "make one move, i.e. from its initial position to a following display position, according to its normal chess movement pattern. If there is more than one direction in which such a move can be made, then, initially, one direction of movement is randomly selected by the controller 44 of the gaming machine 10. As the chess piece moves to each position in its pattern, it being understood that there is an underlying symbol at each such

position, in changes the underlying symbol to that chess piece. When it has completed its move, all wins will be paid in which one or more of the chess pieces substitutes”.

Additionally, Benett discloses automatically expanding wildcard symbols as stated in col. 3, lines 40-44, wherein “whenever any chess piece substitute symbol is spun up and displayed ... the chess piece will make one move, i.e. from its initial display position to a following display positions”. That is, whenever a piece is displayed it will automatically expand, i.e. the wildcard symbol will expand without evaluating anything except whether or not a wildcard symbol is present.

Further, Benett discloses always replacing the symbols in col. 2, lines 15-19, wherein “When the chess piece moves according to its movement pattern it may require any standard symbol is a display position in the movement pattern of the chess piece to which the chess piece moves and may act as a substitute for such standard symbol”, as well as in col. 3, lines 47-50, wherein “As the chess piece moves to each position in its pattern, it being understood that there is an underlying symbol at each such position, it changes the underlying symbol to that chess piece”.

Benett does not specifically disclose automatically expanding wildcard symbols, if displayed in the symbol matrix, in all of the predetermined directions assigned by the directional indicia displayed on each said wildcard symbol. Specifically, Benett discloses that if there is more than one possible direction of movement associated with a wildcard, then the direction of movement is selected by the controller (col. 3, lines 44-47). However, in an analogous slot machine gaming device, Locke discloses the use of wildcard symbols that move to occupy other symbol spaces, i.e. expand from the

original symbol space on which the wildcard symbol appears, such that “the appearance of the symbol itself may be modified such that movement of the symbol is consistent with the type of symbol being moved” (§0027). That is, the direction of movement of the symbol is assigned by the directional indicia displayed on each said wildcard symbol. Further, Locke discloses an embodiment of the invention wherein the symbol expands in all of the predetermined directions as assigned by the directional indicia, as shown in Fig. 7-9. In this embodiment, the balloon wildcard symbol may only move in an upward direction, as governed by the wildcard indicia itself. Because the balloon may only move upward and does so, as shown in Fig. 7-9, the balloon wildcard symbol expands in all of the predetermined directions assigned by the directional indicia.

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the symbol expansion slot machine game of Benett with the symbol expansion slot machine game of Locke in order to produce a slot machine game having expandable wildcard indicia such that the wildcard indicia automatically expands in all of the predetermined directions assigned by the directional indicia displayed on each said wildcard symbol as the slot machine games are analogous inventions in the same field of endeavor. Both games endeavor to provide exciting new features for slot machine games, as disclosed by Benett (col. 1, lines 13-28) and Locke (§ 0002-0003). Further, all of the claimed components were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

Regarding claim 30, the directional indicia for a wildcard symbol assigns one or more of the following predetermined directions upwards, downwards, leftwards, rightwards, and diagonally, as disclosed by Benett (Fig. 3-8) and Locke (§0027).

Regarding the limitation of claim 31, wherein the method described above further comprises a wildcard symbol expands N symbol position, from the symbol position in which the wildcard symbol appears towards the predetermined direction(s) assigned to the wildcard symbol, with N calculated in one of the following manners; N is a fixed number, N is a random number, or N is a random number selected from a range of numbers, Benett discloses that the number of symbols positions that the wildcard symbol expands into may be a fixed number (col. 4, lines 22-45).

Regarding claim 32, Benett discloses the use of words as directional indicia displayed on the wildcard symbol (Fig. 3-8). The word "Bishop" substantially meets the broadest reasonable definition of the term "directional indicia", as the word Bishop indicates the diagonal direction in which the piece must move.

Response to Arguments

Applicant's arguments filed July 13, 2007 have been fully considered but they are not persuasive. Specifically, applicant argues that Benett does not meet the limitation of "the wildcard symbols expand in the direction assigned by the directional indicia". This is not persuasive as for example, the word "Bishop" substantially meets the broadest reasonable definition of the term "directional indicia", as the word Bishop indicates the diagonal direction in which the piece must move. The word Bishop provides a player

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with an indication of the movement pattern or direction of expansion of the piece.

Arguing that the use of board game pieces requires a knowledge of the rules of the board game, and thus a player may not readily know which direction the piece will expand in is not persuasive. The word Bishop provides an indication of a diagonal movement pattern, whether the player recognizes this indication is irrelevant. For instance, a similar argument could be made against the "U" and "D" indicators used in the instant invention, as the player would have to have prior knowledge of the fact that the letter "D" is intended to indicate an downward expansion direction as opposed to a diagonal expansion direction in order to accurately predict the movement pattern of the piece.

Further, applicant's argument that the instant invention teaches methods by which wildcard symbols expand without use of a control means to determine a direction of expansion is also not persuasive. Even if, as applicant states, the direction of expansion is "automatic", i.e. predetermined, it still requires a controller to determine the type of indicia displayed and the corresponding movement pattern. Additionally, the chess pieces of Benett do "automatically expand", as states in col. 3, lines 40-43, wherein "whenever any chess piece substitute symbol is spun up and displayed ... the chess piece will make one move, i.e. from it's initial display position to a following display position, according to its normal chess movement pattern". Benett does not specifically disclose that they automatically expand in all directions, however, this limitation is taught by Locke as described in the above rejection.

Applicant's arguments with respect to the combination of Benett and Bussick have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Meagan Thomasson whose telephone number is (571) 272-2080. The examiner can normally be reached on M-F 830-5.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on (571) 272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Meagan Thomasson
October 4, 2007


XUAN M. THAI
SUPERVISORY PATENT EXAMINER

TL3700